

REMARKS

The foregoing amendments import into claim 1 the feature of claim 21, retain claims 2-14 and 16-20 unchanged, correct a minor clerical error in claim 15, and cancel claim 21 as redundant over amended claim 1. Claims 30-34 have been cancelled as directed to a non-elected invention, but without prejudice to applicants' rights to file divisional and/or continuation applications directed to the subject matter of these claims.

New claims 35-42 have been added to define additional subject matter for which applicants consider they have a right to patent protection. Claim 35 is in effect a version of original claim 1 limited to the use of titania particles and is based, *inter alia*, on Example 6 at Paragraphs 185 to 190, which illustrates the use of a silica-coated titania particle the process of original claim 1. Claims 36-40 are directed to processes according to claim 35 having the additional features of claims 8-10, 14 and 15 respectively. Claim 41 is directed to a process according to claim 35 in which the titania particle used is coated with silica, and is again based, *inter alia*, on Example 6 at Paragraphs 185 to 190. Finally, claim 42 is directed to a process according to claim 35 having the additional feature of original claim 21.

No new matter is introduced by any of the foregoing amendments.

In response to Paragraph 2 of the Office Action, the applicants confirm their earlier telephone election of the species of claims 8 to 10; this election is now made *without traverse*.

In response to Paragraph 3 of the Office Action, it is respectfully submitted that the context requires the word "whereby" rather than "where" at the relevant point in claim 15. However, claim 15 has been amended to correct a clerical error and show "whereby" as one word, not two.

In response to the double patenting rejection set out in Paragraphs 4 and 5 of the Office Action, there is filed herewith a Terminal Disclaimer disclaiming any portion of the term of any patent granted on this application which extends beyond the term of any patent granted on copending Application Serial No. 10/711,829. As noted in

the Office Action, this Terminal Disclaimer must be sufficient to overcome the double patenting rejection.

Since claim 1 has been amended so that it is equivalent in scope to the original claim 21, it is considered that the 35 USC 102 and 103 rejections set out in Paragraphs 6-10 of the Office Action are obviously moot, and that the only rejection to which applicants now need to respond in detail is the rejection in Paragraph 11, the only rejection applied to original claim 21. This rejection is traversed. More specifically, this rejection is traversed on the grounds that Uytterhoeven would not teach a person of ordinary skill in the relevant art that the polymer-coated particles described in Devonport or Sakai would be useful in an electrophoretic medium, and indeed that Uytterhoeven would teaching that the Devonport and Sakai polymer-coated particles would *not* be useful in such a medium.

The "Background of the Invention" section of Devonport discusses prior art relating to growing polymers on carbon black surfaces. The polymer-coated carbon black particles produced are apparently intended as thermal stabilizers in polymeric systems (see column 1, lines 12-18 of Devonport). Sakai describes the preparation of polymer-coated silica particles which are intended as spacers for use in liquid crystal displays (see, for example, the Abstract of Sakai). One of the advantages claimed for the Sakai particles is that when used as spacers in a liquid crystal cell, they do not move after the cell is formed, including the introduction of liquid crystal into the cell (see, for example column 19, lines 4-16 of Sakai). This indicates that the Sakai particles are not readily dispersed in a liquid crystal medium.

Uytterhoeven does indeed teach polymer-coated particles useful in an electrophoretic medium, namely a liquid electrophoretic developer composition. However, Uytterhoeven teaches that, to be useful in such an electrophoretic composition, the particle must have a specific two-part polymer structure, namely at least one polymer ("polymer A") which forms a coating on the pigment (apparently a dried physical coating, judging from the Examples of Uytterhoeven, rather than a chemically-bonded coating as

in Devonport and Sakai) and has poor solubility in the suspending fluid of the electrophoretic composition, and a second polymer ("polymer B") chemically linked to polymer A and having good solubility in the suspending fluid of the electrophoretic composition. It will readily be apparent that none of the polymer-coated particles described in Devonport or Sakai have a polymer layer in any way resembling the two-part polymer layer which Uytterhoeven teaches is needed for dispersing the particle in the electrophoretic composition. Hence, far from teaching that the Devonport or Sakai polymer-coated particles would be useful in an electrophoretic medium, Uytterhoeven actually teaches away from the use of such particles in electrophoretic media.

For the foregoing reasons, the 35 USC 103 rejection is unjustified and should be withdrawn.

Claims 35-42, which are all restricted to treatment of titania particles, are patentable over the references of record. Sakai is explicitly restricted to silica particles, which are shown to have the right physical properties for use as spacers in liquid crystal displays. There is no logical reason why a person skilled in the art would replace silica with titania, a material having very different physical properties, and strong light-scattering properties which would be highly undesirable in a liquid crystal display, which is normally backlit. Similarly, Devonport, as applied by the Examiner, is restricted to carbon black particles useful as thermal stabilizers, and there is no reason to replace such carbon black with titania, a very different material not known to be useful as a thermal stabilizer; given the notorious catalytic and photocatalytic activity of titania, it seems likely to catalyze thermal reactions, not inhibit them.

This application now contains 28 claims, including two independent claims. Since applicants have already paid fees for 29 claims, including four independent claims, no additional claim fees are required in connection with this Amendment.

Since the normal period for responding to the Office Action expired July 26, a Petition for a one-month extension of this period is being filed herewith. A

Honeyman, et al.
Serial No. 10/711,278
Amendment of August 24, 2005
Page 10

Supplemental Information Disclosure Statement, and the relevant fee therefore, are also being filed herewith.

Respectfully submitted



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